

REMARKS

I. Introduction

Applicants thank the Examiner for the telephonic interview of June 3, 2003, and the Examiner's subsequent decision to reopen prosecution of this case.

Pursuant to 37 C.F.R. § 1.136(a), applicants hereby petition for a one-month extension of time to respond to the Office Action dated July 21, 2003. With the extension, a response is due on or before November 21, 2003. A check in the amount of \$110.00, in payment of the fee required under 37 C.F.R. § 1.17(a)(1), is enclosed herewith. The Director is hereby authorized to charge any additional fees that may be due, or to credit overpayment of same, to Deposit Account No. 06-1075. A duplicate copy of this Reply is enclosed herewith.

Claims 1-19 and 37-48 are pending.

Claims 1-19 and 37-48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brenner et al., U.S. Patent No. 5,830,068 ("Brenner '068") in view of Dan Wagner et al., The Human Factors Design Guide ("HFDG"), and Lawler et al., U.S. Patent No. 5,805,763 ("Lawler").

Claims 1-19 and 37-48 were also rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over either claims 1-59 of Brenner et al., U.S. Patent No. 6,004,211 ("Brenner '211") or claims 1-132 of Brenner '068, each in view of HFDG and Lawler.

These rejections are respectfully traversed.

II. Listing of the Pending Claims

Applicants provide herewith a listing of the pending claims in this case (see pages 2-6 of this Reply). In an Amendment to claim 1 filed January 28, 2002, applicants included a correct marked-up amended claim 1, reciting the feature of "automatically providing the user with an option to record the given race ..." (See the Appendix of applicants' January 28, 2002 Reply). However, applicants have recently discovered that an incorrect claim 1, in clean format, was submitted reciting the feature of "automatically prompting the user to decide whether to record the given race ..." (see page 2 of applicants' January 28, 2002 Reply). Accordingly, in order to clarify any confusion that may have occurred due to this inadvertent error, applicants have provided herewith a correct listing of the claims.

III. Applicants' Reply to the Rejections Under § 103(a)

Claims 1-19 and 37-48 were rejected under 35 U.S.C. § 103 as being unpatentable over Brenner '068 in view of HFDG and Lawler. Applicants' independent claims 1, 19, 37, and 48 generally relate to systems and methods for allowing users to wager on and record wagering events. As set forth in independent claims 1 and 37, a user is allowed to "create and place a wager for a given race by interacting with a plurality of wager creation options," and is automatically provided with an option to record a race "while the user is interacting with the plurality of wager creation options." Applicants' independent claims 19 and 48 recite "allow[ing] the user to create and place a wager for a given race" and automatically providing the user with an opportunity to record the given race "in response to the user placing the wager for the given race."

As stated in the Office Action, Brenner '068 discloses an interactive wagering system that allows users to interact with a plurality of wager creation options and place bets. See, for example, FIGS. 36-39 and 41-44 of Brenner '068. Brenner '068 also shows that a selectable option associated with a given race may be presented, and that the user may select the option to record the race. See FIG. 49 and the accompanying text at column 28, lines 4-23. However, the Office Action concedes that Brenner does not show "automatically prompting the user to decide whether to record the race while interacting [with] the plurality of wager creation option." See page 14 of the Office Action.

The Office Action attempts to show this feature of applicants' claims using disclosure from Lawler.* Lawler, however, generally relates to an interactive television program guide for allowing users to browse and selecting television programs. See abstract. Lawler also shows that a selectable option (130) associated with a given television program may be presented, and that the user may select the option to record the television

* Applicants would like to point out that this feature is not present in applicants' pending claims. Applicants believe that the Examiner may incorrectly believe this feature to be part of applicants' claims because of applicants' inadvertent error in presenting a clean version of claim 1 in applicants' Reply to Office Action filed January 28, 2002. Instead, applicants submit that claims 1 and 37 include the feature of automatically providing the user with an option to record the given race while the user is interacting with the plurality of wager creation options, and that claims 19 and 48 include the feature of automatically providing the user with an opportunity to record a given race in response to the user placing a wager for the given race. Applicants have assumed, for the purpose of this Reply, that the Examiner would have relied on Lawler to show these features of applicants' claims.

program. See FIG. 6 of Lawler. When a user selects the record option in Lawler, the user is presented with additional record options. See FIG. 9. Indeed, both Lawler and Brenner '068 show similar techniques for allowing users to record a program and a race, respectively (i.e., allowing users to navigate a content selection menu that provides a selectable option for allowing users to record content). However, neither Brenner '068, Lawler, nor their combination show or suggest automatically providing the user with an opportunity to record a race "while the user is interacting with the plurality of wager creation options" or "in response to the user placing the wager for the given race" as specified by applicants' claims.

The Office Action also relies on HFDG to show these features of applicants' claims. However, HFDG is described as "a comprehensive reference tool that will help human factors professionals within the Federal Aviation Administration (FAA) and contractor organizations to efficiently carry out FAA human factors policy." See page i of the Foreword. In addition, HFDG "provides reference information to assist in the selection, analysis, design, development, and evaluation of new and modified FAA systems, facilities, and equipment." See page 1-1. Although HFDG does, as the Office Action suggest, refer to various fundamental goals for implementing human-computer interfaces, HFDG fails to refer to designing interactive wagering interfaces. Furthermore, HFDG fails to make any reference to allowing a user to interact with a plurality of wager creation options, allowing a user to place a wager, allowing a user to record wagering events, or any combination of these features of applicants' claims.

Nevertheless, the Office Action indicates that the teachings of Lawler and HFDG would have suggested to one skilled in the art to modify Brenner '068 to achieve the benefit of applicants' claimed approach. See pages 19-20 or the Office Action. Specifically, the Office Action concludes that:

it would have been obvious ... to modify the off-track wagering system disclosed by Brenner to add the feature of automatically prompting the user to decide whether to record the race while interacting with the plurality of wager creation options.

See page 20 of the Office Action. The Examiner appears to rely on various generic and fundamental goals set forth in HFDG (e.g., for optimizing human-computer interfaces) to suggest that applicants' claims would have been obvious in light of Brenner '068 and Lawler (see page 20 of the Office Action). However, as discussed above, HFDG provides reference information for Federal Aviation Administration systems and equipment and does not refer at all to interactive wagering applications or recording wagering events. Accordingly, HFDG fails to show or suggest applicants' claimed arrangement for automatically providing a user with an opportunity to record a race "while the user is interacting with [a] plurality of wager creation options" or "in response to the user placing [a] wager for [a] given race" as specified by applicants' claims. Therefore, because neither Brenner '068, Lawler, HFDG, nor their combination show or suggest these features of applicants' claims, applicants respectfully submit that a *prima facie* case of obviousness had not been met and that the § 103 rejections should be withdrawn. See MPEP § 2143.

Moreover, the above statement of motivation provided by the Examiner is tantamount to saying that it would have been obvious to modify Brenner '068 with Lawler because it would have led to applicants' novel approach. It is well-settled, however, that to establish a *prima facie* case of obviousness, an objective reason or motivation must be provided that would lead one skilled in the art to selectively modify the prior art to arrive at applicants' claimed approach. See *In re Rouffet*, 149 F.3d 1350, 1357; see also *In re Lee* 277 F.3d 1338. Applicants respectfully submit that there is no objective evidence of record, other than applicants' disclosure, that would lead one skilled in the art to modify Brenner '068, Lawler, and HFDG to automatically provide users with an option to record a race "while the user is interacting with the plurality of wager creation options" or "in response to the user placing the wager for the given race" as specified by applicants' claims.

Without objective evidence of a motivation to modify the references to arrive at applicants' claimed approach, the Office Action "simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability," a practice that is insufficient as a matter of law. See *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999); see also *In re Lee* at 1344 ("[i]t is improper, in determining whether a person of ordinary skill would have been led to a combination of references, simply to use that which the inventor taught against its teacher"). For at least this reason, applicants respectfully request that the § 103 rejections should be withdrawn.

IV. Applicants' Reply to the Double Patenting Rejections

Claims 1-19 and 37-48 were rejected under the judicially created doctrine of obviousness-type double patenting (analogous to a rejection under 35 U.S.C. § 103 according to MPEP § 804(II)(B)(1)) as being unpatentable over either claims 1-59 of Brenner '211 or claims 1-132 of Brenner '068, each in view of HFDG and Lawler. Applicants respectfully submit, however, that the obviousness-type double patenting rejections are improper in this case.

It is well settled that, in cases where double patenting may be at issue, "it must always be carefully observed that the ... patent [used as the basis for a double patenting rejection] is not 'prior art' under either section 102 or section 103 of the 1952 Patent Act (35 U.S.C. as amended)." In re Boylan, 392 F.2d 1017, 1018; see also In re Braithwaite, 379 F.2d 594, 600, n.4 ("While analogous to the non-obviousness requirement of 35 U.S.C. § 103, that section is not itself involved in double patenting rejections because the patent principally underlying the rejection is not prior art"). Indeed, the courts have determined that double patenting rejections are reserved for situations "where patents are not citable as a reference against each other and therefore can not be examined for compliance with the rule that only one patent is available per invention." Eli Lilly & Co. v. Barr Labs., 251 F.3d 955, 966 (Circuit Judge Newman dissenting, in a separate opinion, on the Court's refusal to reconsider the case en banc); see also General Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 1278.

In the present case, Brenner '068 was filed on September 8, 1995 and issued on November 3, 1998, which is

before the date of applicants' claimed invention.*
Accordingly, the claims and disclosure of Brenner '068 are statutory prior art under 35 U.S.C. § 102(a). Therefore, the double patenting rejections based on the claims of Brenner '068 are improper. See MPEP § 804. Moreover, Brenner '211 claims priority from Brenner '068 and the claims of Brenner '211 are therefore fully supported by the disclosure of Brenner '068. Accordingly, the obviousness-type double patenting rejections based on the subject matter of claims 1-59 of Brenner '211 are also improper because this subject matter is fully supported by Brenner '068, which is statutory prior art under 35 U.S.C. § 102(a). For at least these reasons, the obviousness-type double patenting rejections should be withdrawn.

However, even if the double-patenting rejections are found to be proper, applicants respectfully submit that, for the same reasons set forth above in connection with the rejections under § 103, applicants' claims 1-19 and 37-48 are not obvious in view of claims 1-132 of Brenner '068 and claims 1-59 of Brenner '211, each in view of HFDG and Lawler.

* Applicants' non-provisional patent application was filed on January 30, 2000 and claims priority from U.S. provisional patent application No. 60/142,174, filed July 1, 1999.

V. Conclusion

The foregoing demonstrates that the obviousness-type rejections of claims 1-19 and 37-48 should be withdrawn. This application is therefore in condition for allowance. Reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "James A. Leiz", is written over a horizontal line.

James A. Leiz
Registration No. 46,109
Agent for Applicants
FISH & NEAVE
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020-1104
Tel.: (212) 596-9000